

Appl. No. 09/816,191
Reply to Office action of May 20, 2004

REMARKS

In the May 20, 2004 Office Action, claims 1-4 were rejected. This Response amends claims 1 and 3, and amends the specification and drawings to correct minor inconsistencies in the original text. This Response also adds new claim 5 for consideration. No new matter has been introduced. After entry of the foregoing amendments, claims 1-5 (5 total claims; 2 independent claims) remain pending in the application. Reconsideration of the application is respectfully requested in view of the above amendments and the following remarks.

Claims 1 and 3 stand rejected under 35 U.S.C. §112, second paragraph. Claims 1 and 3 have been amended such that they now unambiguously comport with the requirements of §112. Accordingly, Applicant respectfully requests the withdrawal of the §112 rejection of claims 1 and 3.

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Field et al., U.S. Pat. No. 6,253,324 (hereinafter "Field") in view of Gennaro et al., U.S. Pat. No. 6,292,897 (hereinafter "Gennaro"). Applicant traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify a reference or to combine the teachings of multiple references. Second, there must be a reasonable expectation of success. Third, the prior art must teach or suggest all of the recited claim limitations. Of course, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. Applicant respectfully submits that the Examiner has not met all of the above criteria.

The Examiner's primary reference, Field, discloses a method of verifying the integrity of client programs that request services from server programs, where the client programs and the server programs are resident on the same computer [see the Abstract; Column 5, Lines 10-15; Column 6, Lines 17-23]. In other words, Field uses the terms "client" and "server" to mean two logical software components operating on the same computer. Field discloses the verification or comparison of a first image of a program stored in secondary storage of the computer (i.e., the hard disk) to an executable image of the same program stored in executable memory of the same computer (i.e., RAM) [Column 7, Line 54 to Column 8, Line 43]. Field also discloses the verification or comparison of a first image of a program stored in secondary storage of the

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computer (i.e., the hard disk) to a cryptographic representation of the image file previously stored on the same computer [Column 7, Lines 25-53]. Field does not specifically describe the verification of software in a remote device using a remotely connected and distinct host device, as recited in Applicant's claims.

Applicant believes that the Examiner's comparison of Field to Applicant's claims is based on a mischaracterization of Field's disclosure. Notably, Field contains no disclosure of communication between a host device and a remote device during the verification process. For example, in contrast to the conclusions reached in section 6 of the Office Action, Field does not teach many of the features recited in Applicant's claims, including at least the following: providing a copy of a memory associated with the remote device to the host; transmitting a seed and indicia of a memory subset from the host to the remote device; executing, by the remote device, the hash function on the memory subset containing said seed; determining, by the remote device, a remote hash value; transmitting the remote hash value from the remote device to the host; and comparing, by the host, the host hash value to the remote hash value. Consequently, the proposed combination of Field and Gennaro fails to teach or suggest each and every limitation of Applicant's claim 1 (and claims 2-4, which variously depend from claim 1).

For at least the above reasons, the proposed combination of references is improper and the Examiner has not met all of the criteria to establish a *prima facie* case of obviousness. Accordingly, independent claim 1 and dependent claims 2-4 are not unpatentable over Field in view of Gennaro, and Applicant requests withdrawal of the §103(a) rejections of those claims.

New claim 5 also recites limitations that are neither taught nor suggested by the prior art of record and, therefore, Applicant submits that claim 5 is also allowable.

In conclusion, for the reasons given above, all claims now presently in the application are believed allowable and such allowance is respectfully requested. Should the Examiner have any questions or wish to further discuss this application, Applicants request that the Examiner contact the undersigned attorney at (858) 350-4222.

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If for some reason Applicant has not requested a sufficient extension and/or has not paid a sufficient fee for this response and/or for the extension necessary to prevent abandonment on this application, please consider this as a request for an extension for the required time period and/or authorization to charge Deposit Account No. 50-2091 for any fee which may be due.

Respectfully submitted,

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Dated: 8/17, 2004

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